

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Matthew J. Mason
Serial No.: 09/115,273
Filing Date: July 14, 1998
Group Art Unit: 2173
Confirmation No. 1196
Examiner: Cao H. Nguyen
Title: METHOD AND APPARATUS FOR INTERACTING WITH A SOURCE CODE CONTROL SYSTEM

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the rejection of all claims in the Application.

Throughout prosecution of this case, the PTO has rejected Applicant’s claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,339,826 issued to Hayes, Jr. et al. (“*Hayes*”) in view of U.S. Patent No. 6,105,027 issued to Schneider et al. (“*Schneider*”). Although Applicant appreciates the PTO’s indication in the most recent Office Action mailed on May 26, 2006, that Claims 17-20, 41-44, 65-68, and 81 are allowable, Applicant submits this Pre-Appeal Brief Request for Review (“Request”) because the PTO’s rejections and assertions relating to remaining Claims 21-24, 45-58, 69-72, and 82-87 contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action (the “Final Office Action”) to establish a *prima facie* rejection under 35 U.S.C. § 103(a) of at least independent Claims 21, 45, 69, 82, 84, 86, and 87 of the present Application. Because the proposed *Hayes-Schneider* combination does not disclose, teach, or suggest each and every element recited in at least independent Claims 21, 45, 69, 82, 84, 86, and 87, these rejections fail to meet the required *prima facie* standard for rejections.

For example, in a Response to Office Action submitted on August 31, 2005 (“*August 31 Response*”), Applicant amended each pending independent claim (including Claims 21, 45, 69, 82, 86, and 87) to recite that the objects upon which configuration management functions are performed or managed include “objects . . . comprising items that are associated with the DAL01:915321.1

development of a product.” Claim 84 was amended to recite the performance of configuration management function on objects “**includ[ing] versions associated with the development of a product.”** Applicant then demonstrated that the recited features and operations were absent from the proposed *Hayes-Schneider* combination. Specifically, Applicant showed that *Hayes* merely relates to a client-server system that allows an administrator to configure user preferences and user permissions so that users may gain access to applications using a desktop computer. (*August 31 Response*, page 19). It was Applicant’s contention that *Hayes* does not at all relate to the performance or management of “objects . . . comprising items that are associated with the development of a product,” as recited in Applicant’s independent claims. These positions are described more fully on page 19 of Applicant’s *August 31 Response*.¹

In the subsequent Office Actions mailed December 12, 2005 and May 26, 2006 (the “*December 12 Office Action*” and “*May 26 Office Action*,” respectively), the PTO has maintained the rejection of the independent claims over the proposed *Hayes-Schneider* combination. In each, Applicant is referred to previously cited portions of *Hayes* for disclosure of the newly added claim language. The two Office Actions also state:

Applicant argues that the combination of *Hayes* and *Schneider* do not teach or suggest “configured to perform configuration management functions on objects within the configuration management system.” However, the limitations as claimed which broadly read on Hayes “FIG. 1 shows one high level view of an intended environment for practicing the invention . . . There is not intent to limit the environment in which the invention might be practiced; indeed a network of any type that interconnects many types of stations is envisioned . . .

(*December 12 Office Action*, page 6-7; *May 26 Office Action*, pages 6-7). Applicant believes that the position of the Examiner is factually and legally flawed for two reasons. First, Applicant notes that the Examiner has over simplified and misstated Applicant’s argument. Applicant’s argument has been and continues to be that the proposed *Hayes-Schneider* combination does not disclose, teach, or suggest the performance of or management of the performance of “configuration management functions on objects . . . comprising items that are associated with the development of a product.” Thus, Applicant does not merely argue that the proposed combination of references fails to disclose, teach, or suggest the performance of configuration management functions on objects within the configuration management system as suggested by the Examiner in the *December 12 Office Action* and in the *May 26 Office Action*.

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that “Applicants are encouraged to refer to arguments already of record rather than repeating them in the request.” Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

For example, in Applicant's Response submitted on March 9, 2006 ("March 9 Response"), Applicant noted the PTO's continued reliance on *Hayes* for disclosure of "objects . . . comprising items that are associated with the development of a product," as recited in Applicant's independent claims. In response to the apparent misstatement and oversimplification of Applicant's position, Applicant also questioned whether the Examiner had improperly equated the claim language with a recitation of an intended use and, thus, had not properly given patentable weight to the recited claim language. It was Applicant's contention that the Examiner's failure to give patentable weight to the recited claim language is improper. The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. Since the claim elements reciting that the objects comprise "items that are associated with the development of a product" are positively recited elements, it was Applicant's contention that the Examiner must give credence to these elements in considering the patentability of the claims. Additionally, Applicant contended that the claimed features do not naturally flow from the suggestion of *Hayes* and *Schneider* and would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention. These positions are described more fully on pages 23-24 of Applicant's *March 9 Response*.²

In the *May 26 Office Action*, the Examiner's response to Applicant's arguments is again merely a recitation of Column 7, lines 1-67 of *Hayes*. Again, the *May 26 Office Action* does not respond specifically to Applicant's arguments relating to the claim language reciting "objects . . . comprising items that are associated with the development of a product." Thus, even without affirmatively saying so, it appears that the *May 26 Office Action*, like the Office Action before it, does not give patentable weight to the recited claim language. Because the *May 26 Office Action* is not giving consideration to each element of Applicant's claims, Applicant contends that the *May 26 Office Action* is factually and legally flawed.

Second, although the two most recent Office Actions extensively quote portions of *Hayes*, the Examiner does not indicate how the quoted portions disclose, teach, or suggest the performance of or management of the performance of "configuration management functions **on objects . . . comprising items that are associated with the development of a product,**" as recited in independent Claims 21, 45, 69, 82, 86, and 87. The *December 12 Office Action* and *May 26 Office Action* similarly fail to indicate how the quoted portions disclose, teach, or suggest "the performance of configuration management function **on objects "includ[ing] versions associated with the development of a product,"**" as recited in independent Claim 84. The Office Actions merely point to Column 7, lines 1-67 of *Hayes* for disclosure of the recited claim

² It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

elements. Applicant has repeatedly shown, however, that *Hayes* does not disclose, teach, or suggest the above-recited features and operations.

For example, Applicants demonstrated in the *August 31 Response* that *Hayes* merely relates to a “client-server system for maintaining a user desktop consistent with server application user access-permissions.” (Title). Specifically, *Hayes* discloses a “profile management administrative operating environment” that includes an administrator client network computer 200 and a server 202. (Figure 2; Column 7, lines 46-50). With regard to profile management functions, *Hayes* discloses that the “[p]rofile manager 206 on the client side allows the administrator to configure user applet preferences at both user and group levels.” (Column 7, lines 54-61). Thus, “the administrator can create new users and group hierarchies, add users to different groups, specify applet permissions for each group and for individual users.” (Column 7, lines 54-61). Accordingly, Applicant has contended and continues to contend that *Hayes* is limited to a client-server system that allows an administrator to configure user preferences and user permissions so that users may gain access to applications using a desktop computer. (See generally, Abstract, Column 7, lines 1-67; Column 8, lines 7-9). There is no disclosure in *Hayes* of the performance of or management of the performance of “configuration management functions **on objects . . . comprising items that are associated with the development of a product,**” as recited in independent Claims 21, 45, 69, 82, 86, and 87. Although *Hayes* states that “[t]here is not intent to limit the environment in which the invention might be practiced,” *Hayes* clearly does not relate at all to the development of a product as recited in Applicant’s claims. Because these deficiencies are not cured by the proposed combination of *Schneider* with *Hayes*, Applicant submits that the *May 26 Office Action* is factually and legally flawed.

For at least these reasons, Applicant submits that independent Claims 21, 45, 69, 82, 84, 86, and 87 and their respective dependent claims are allowable.

As still other examples of the deficiencies of the *Hayes-Schneider* combination, Applicant has repeatedly demonstrated that the proposed combination fails to disclose, teach, or suggest “a registration device configured to register an application as associated with a type of version” and “a view version device configured to, check out a version from said configuration management system, and execute an application registered as associated with the version checked out,” as recited in independent Claim 84 and as analogously recited in independent Claims 86 and 87. This position was first described on pages 21-22 of Applicant’s *August 31 Response*. Specifically, Applicant demonstrated that the portion of *Hayes* cited by the Examiner merely discusses the treatment by the *Hayes* system of preferences and permissions. Although the cited portion of *Hayes* discusses registering, it does so in the context of requiring an “applet to register with ProfileManagementProperties 510” before the applet can run in the profile management framework. (Column 12, lines 29-32). There is no disclosure, however, in *Hayes* of “a DAL01:915321.1

registration device configured to register an application as associated with a type of version," as recited in Claim 84 (emphasis added) and similarly recited in Claims 86 and 87. And, certainly there is also no disclosure of "a view version device configured to, check out a version from said configuration management system, and execute an application registered as associated with the version checked out," as recited in Claim 84 and similarly recited in Claims 86 and 87.

The *December 12 Office Action* failed to respond to Applicant's above-summarized arguments. Accordingly, Applicant noted this deficiency in the *March 9 Response* and reiterated Applicant's arguments with respect to the distinctions between independent Claims 84, 86, and 87 and the proposed *Hayes-Schneider* combination. Nevertheless, the most recent *May 26 Office Action* again fails to respond to Applicant's arguments relating to Claims 84, 86, and 87. Accordingly, Applicant submits that the *May 26 Office Action* is legally and factually flawed both because the proposed *Hayes-Schneider* combination fails to disclose, teach, or suggest each and every element recited in Applicant's Claims 84, 86, and 87 and because the PTO's repeated failure to respond to Applicant's arguments renders the *May 26 Office Action* incomplete.³

For at least these additional reasons, Applicant submits that independent Claims 84, 86, and 87 and their respective dependent claims are allowable.

CONCLUSION

As the rejections of Claims 21-24, 45-58, 69-72, and 82-87 contain clear deficiencies, Applicant respectfully requests a finding of allowance of Claims 17-24, 41-48, 65-72, and 81-87. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,
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³ Section 707.07(f) of the M.P.E.P. requires an Examiner to answer all material traversed by an Applicant. Specifically, that provision states, "Where the applicant traverses any rejection, the examiner should if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." DAL01:915321.1